

REMARKS/ARGUMENTS

Applicant acknowledges receipt of the Office Action dated August 22, 2006. Claims 1-4 and 6-9 are pending in this application of which 1, 8 and 9 are independent. By this Amendment, claims 1, 3, 4, 8 and 9 are amended. Claim 5 is cancelled without prejudice to, or disclaimer of, the subject matter recited therein.

Rejections under 35 U.S.C. § 101

On pages 2-3, the Office Action rejects claims 1-8 under 35 U.S.C. § 101. This rejection is respectfully traversed.

Regarding claim 8, the Office Action sets forth the rejection in the first full paragraph on page 2. Claim 8 recites, "a tangible media containing code for a computer program." It is respectfully submitted that the tangible media recited in claim 8 constitutes statutory subject matter under 35 U.S.C. § 101.

The Office Action sets forth the rejection of claims 1-7 under 35 U.S.C. § 101 in the paragraph bridging pages 2 and 3 of the Office Action. Claim 5 is cancelled without prejudice to, or disclaimer of, the subject matter recited therein, that subject matter having been incorporated into claim 1. Claims 2-4, 6 and 7 depend from claim 1. Claim 1 recites a method of "producing and displaying an image on a display screen." Claim 1 further recites that, "a resulting image is displayed on a display screen." Applicant respectfully asserts that the method of producing and displaying an image on a display screen recited in claim 1 constitutes statutory subject matter under 35 U.S.C. § 101.

For at least the foregoing reasons, it is respectfully requested that the rejections of claims 1-8 under 35 U.S.C. § 101 on pages 2-3 of the Office Action be withdrawn.

Rejection under 35 U.S.C. § 102

On pages 4-7, the Office Action rejects claims 1, 2 and 6-9 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,531,227 to Schneider. This rejection is respectfully traversed.

Claim 1 recites that, "at least one depth associated with the identified surfaces is selected from a priori information." Claims 6 and 7 depend from claim 1. Claims 8 and 9 contain nearly identical recitations. The above-quoted subject matter was previously recited in claim 5. Claim 5 was not subjected to this rejection. In the first full paragraph on page 8, the Office Action correctly concedes that Schneider fails to disclose, teach or suggest this subject matter. Applicant respectfully submits that this concession in the Office Action correctly identifies a deficiency in Schneider with respect to the above-quoted subject matter.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1, 2 and 6-9 as being allegedly anticipated by Schneider be withdrawn.

Rejections under 35 U.S.C. § 103

On pages 7-8, the Office Action rejects claims 3 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Schneider in view of U.S. Patent No. 6,421,454 to Burke et al. (hereinafter "Burke"). This rejection is respectfully traversed.

Claim 5 is cancelled without prejudice to or disclaimer of, the subject matter recited therein. Regarding claim 3, it is impermissible for an Examiner to engage in hindsight reconstruction of the

prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

"The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). Here, it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the subject matter according to the combinations recited in the rejected claims. The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Here, it appears that the Examiner improperly relies on the Examiner's own "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry. In other words, the Examiner attempts to substitute facts within the personal knowledge of the Examiner for a reference showing the asserted motivation to combine the references. Applicant respectfully submits that this is improper for at least the following reasons.

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According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon within the Examiner's own knowledge, subject to contradiction or explanation by the Applicant and other persons. Applicant requests such an affidavit.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

Claim 1 is amended to correspond to claim 5 rewritten in independent form. It is respectfully submitted that claim 1 is patentable over the combination of Schneider and Burke. As previously mentioned, on page 8, the Office Action correctly concedes that Schneider fails to disclose, teach or suggest the subject matter quoted above in connection with claim 1. In order to overcome this correctly admitted deficiency in Schneider, the Office Action relies on Burke. Specifically, the Office Action relies on col. 11, lines 25-29 of Burke. However, Burke merely discloses that the transformed images are stored and then the image processor 14 defines slices. Burke does not disclose, teach or suggest that the depth associated with the identified surface is selected from a priori information.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 3 and 5 as allegedly being unpatentable over Schneider in view of Burke be withdrawn, and further that the rejection not be applied to claim 1.

On pages 8-9, the Office Action rejects claim 4 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schneider in view of U.S. Patent No. 5,371,778 to Yanof et al. (hereinafter "Yanof"). This rejection is respectfully traversed.

In the first sentence of the paragraph bridging pages 8 and 9, the Office Action correctly concedes that Schneider fails to disclose, teach or suggest the subject matter recited in claim 4. In order to overcome this admitted deficiency in Schneider, the Office Action relies on Yanof. However, as previously mentioned, it is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

"The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). Here, again with respect to claim 4, it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the subject matter according to the combinations recited in the rejected claims. The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved

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on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Regarding the rejection of claim 4, it appears that the Examiner improperly relies on the Examiner's own "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry. In other words, the Examiner attempts to substitute facts within the personal knowledge of the Examiner for a reference showing the asserted motivation to combine the references. Applicant respectfully submits that this is improper for at least the following reasons.

As with claim 3, according to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon within the Examiner's own knowledge, subject to contradiction or explanation by the Applicant and other persons. Applicant requests such an affidavit.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

For at least the foregoing reasons it is respectfully requested that the rejection of claim 4 as allegedly being unpatentable over Schneider in view of Yanof be withdrawn.

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CONCLUSION

In view of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the correspondence attorney listed below in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
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